



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of: )  
David A. Russo, et al. ) Group Art Unit 1108 ✓  
                        ) )  
Serial No. 08/544,212 ) Examiner: Brunsman  
                        ) )  
Filed: October 17, 1995 ) )  
                        ) )  
For: COATING COMPOSITION ) )  
FOR GLASS ) Attorney Docket 1-15182  
                        ) )

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GROUP 1100

January 29, 1997

Assistant Commissioner for Patents  
Washington, D.C. 20231

Attention: Director, Group Art Unit 1108

**PROTEST UNDER 37 C.F.R. §1.291(a)**

Honorable Sir:

This is a Protest against the above identified reissue application. While protestor filed an earlier protest in this application, this protest is limited to a new issue which could not have been raised in the previously filed protest.

Specifically, an issue has arisen as to whether a restriction requirement had been entered in the original application which would bar some of the reissue claims based on the recapture doctrine as set forth in *In re Orita et al.*, 193 USPQ 145 (CCPA 1977). At page 5 of the remarks filed with the Amendment dated November 27, 1997, the applicant first raised this issue, by asserting that "there was no restriction requirement entered in the original application." Applicant's position in this regard was not, and could not have been, known or reasonably anticipated at the time of the filing of the earlier protest.

As held in *In re Orita et al.*, it is not "error" under 35 USC §251 where the patentee acquiesces in an Examiner's requirement for restriction. *In re Orita et al.*, 193 USPQ at 145. Patentees are therefore estopped from obtaining, by reissue, claims which the patentee could not claim in the original patent because of a requirement for restriction in which the patentee acquiesced. *Id.*

In the Amendment dated November 27, 1997, the applicant noted that the "original application" was filed as part of a national phase entry from a PCT application pursuant to 35 USC §371. However, the applicant failed to note that the subject PCT application was filed based upon two earlier U.S. applications. Thus, as noted on the front page of the original patent, the "original application" is a continuation-in-part of U.S. patent applications Serial No. 07/814,366 filed December 26, 1991 (the '366 application) and Serial No. 07/814,352 filed December 27, 1991 (the '352 application).

Restriction requirements were in fact entered in both of these parent applications. In an Examiner's Action dated September 28, 1992 in the '352 application, restriction was required under 35 USC §121 between the invention of claims 1-27 and that of claims 28-51. Similarly, in an Examiner's Action dated September 29, 1992 in the '366 application, restriction was required under 35 USC §121 between the invention of claims 1-19 and that of claims 20-50.

It has long been held that "[w]hen an application satisfies the requirements for continuing application status, as in this case, the parent and continuing applications 'are to be considered as parts of the same transaction, and both as constituting one continuous application, within the meaning of the law.'" *Square Liner 360 °, Inc. v. Chisum*, 216 USPQ 666, 673 (8th Cir. 1982), citing *Godfrey v. Eames*, 68 U.S. (1 Wall.) 317, 326 (1863).

Thus, the '366 and '352 applications are a part of the same transaction as the "original application", and it is as if the restriction requirements entered in those parent applications were directly entered in the "original application".

Furthermore, an estoppel is not avoided simply by filing narrowed continuing applications rather than responding directly to an examiner's action. See, for example, *Mark I Marketing Corp. v. R.R. Donnelly & Sons Co.*, 36 USPQ 2d 1095, 1100 (Fed. Cir. 1995), as well as MPEP §§ 818.01, 818.02, and 818.02(a). Thus, the patentees' failure to obtain the method and article claims in the original patent was a deliberate response to the respective restriction requirements set forth in the parent applications, and is not an "error" of the type required by 35 USC §251. *In re Orita et al.*, 193 USPQ at 148.

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The recapture of these claims would be improper, and the claims should be rejected  
on this basis.<sup>1</sup> Accordingly, an Examiner's Action to that effect is respectfully requested.



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<sup>1</sup>The claims should be further rejected on the bases set forth in the earlier protest, including that the reissue claims are anticipated under 35 USC §102(b) or, in the alternative, obvious under 35 USC §103, issues that the Examiner has postponed addressing.



CERTIFICATE OF SERVICE

It is hereby certified that a copy of this Protest under 37 C.F.R. 1.291(a) was mailed, first class, postage prepaid, to Luke A. Kilyk at Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P., 1300 I Street, N.W., Washington, DC 20005, attorney for reissue applicant, this 29<sup>th</sup> day of January, 1997.

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